

REMARKS

Claims 1, 4, 6-11, 14 and 16-22 are pending in the application.

Claims 1, 4, 6-11, 14 and 16-22 are rejected.

Reconsideration and allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1, 4, 6-11, 14 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman (U.S. Publication No. 2004/0260843) (Sleeman) in view of Saunders (Newcard Exposed) (Saunders), and further in view of Ahern (U.S. Patent No. 6,070,214) (Ahern). Claims 9-10 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman, as applied to Saunders, and further in view of Cheng et al (U.S. Patent No. 6,935,130) (Cheng). This rejection is not applicable to the amended claims.

Independent claims 1, 11 and 21 all require a Newcard device including “power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device.”

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, at least do not teach the second subsystem deriving power from the computer via a powerline of the Newcard device,

as required by independent claims 1, 11 and 21. The Examiner states that "Sleeman as modified by Saunders does not explicitly disclose a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the [N]ewcard device." The Applicants submit that Ahren does not cure this deficiency. The Examiner argues "Ahren teaches in Figure 3 of docking station comprising a console 90 and a power adapter 120. AC input supplies power to the docking station and the power supply 120. AC input supplies power to the docking station and the power supply 120 produces the voltages for the various components of the system." Ahren does disclose a power supply 120 as "producing a variety of supply voltages to power various components." (Col. 8 lines 66-67) However, Ahren does NOT disclose a subsystem deriving power from a computer via a Newcard device, as required by the claims. Claims 1, 11 and 21 require power means to provide power to a second subsystem including both "a power adapter..." and "deriving power...via a powerline of the Newcard device."

Claims 4, 6-10, 14, 16-20 and 22 depend from and further limit independent claims 1, 11 and 21 respectively and are allowable for at least the same reasons as stated above. In particular, claims 9-10 and 19-20 were rejected Sleeman, as applied to Saunders, and further in view of Cheng. Cheng also does not disclose a subsystem deriving power from a computer via a Newcard device, as required by the claims. Cheng discloses only a computer cooling system associated with a cooling fan.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must

be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ___, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

In the present case, the Examiner has not expressed a reason why a person of ordinary skill in the art would combine the references of Sleeman, Saunders, Ahren, and/or Chen. The Examiner argues "One of ordinary skill in the art would be motivated to use the power system of Severson to power the system of Sleeman modified by Saunders as the multi-purpose nature of the computer requires the support of different I/O systems within the given device." Severson is not a reference upon which the current rejection of the claims is based. As such, the Examiner expresses no reason as to the combination of Ahren. Furthermore, "the multi-purpose nature of the computer" does not provide a reason that one of ordinary skill in the art would provide, for example, a Newcard device including power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device. In view of the above, a person of ordinary skill in the art would not have a reason to combine Sleeman and Saunders, with Ahren. Therefore, there is simply no basis for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of

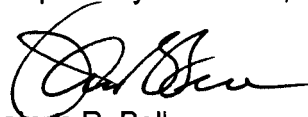
obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 11 and 21 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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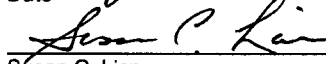
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Susan C. Lien